## REMARKS

The Office Action of August 5, 2009, has been carefully considered. Reconsideration of this application in view of the proposed amendments and arguments set forth herein is respectfully requested.

*Amendments Proposed to Dependent Claims 13 – 15*

Applicants respectfully request that the amendments proposed to dependent claims 13 – 15 be entered as set forth in the Listing of Claims above. Although presented after a Final Office Action, the claim amendments are believed to address an inconsistency in the claim dependency that was only recently identified by Applicants upon further review of dependent claim 14. In particular, claims 13 – 15 each recite "the record-set," yet were dependent from claim 7 which did not set forth such a limitation. Accordingly, in order to provide an antecedent basis for each element recited in claims 13 – 15, Applicants propose amending claims 13 – 15 so that each reflects a corrected dependency from claim 10, also dependent from claim 7, which first introduces "a record-set." Entry of the proposed amendments is respectfully requested as this amendment is believed to further reduce the matters that would be addressed on appeal – even though no rejection has yet been set forth relative to antecedent basis of claims 13 - 15. Applicants further urge that the limitations set forth in the claims themselves have not been changed by this amendment so as to require a new search. Accordingly, acknowledgement of the entry of the proposed amendments is respectfully requested.

*Summary of Application Status*

Claims 1 – 20 remain pending.

Claims 13 – 15 are proposed for amendment.

Claim 1-13 and 15-20 were rejected under 35 USC §103(a) as being unpatentable over Raveis (US2001/0005829A1) in view of Guardian Mortgage Documents ("GMD"). Claim 14 was rejected under 35 USC §103(a) as being unpatentable over Raveis in view of GMD and further in view of Bisbee (US 7,162,635).

*Information Disclosure Statement*

In an effort to assure the Examiner's consideration of various documents pertaining to the prosecution of a related application (parent U.S. Application No. 09/971,516, filed October 5, 2001), Applicants previously identified specific pages of the parent application for the Examiner's consideration. While Applicants respectfully believe that it is the Examiner's obligation to thoroughly consider the related application in its entirety, the Examiner has nonetheless requested specific citations and relevance. As noted, Applicants identify the following pages as the specific citations requested for the Examiner's consideration: pp. 2, 5-21, 26-35, 42-63, 68-107, 109, 111, 113-127, 129-132, 135-142, 144-151, 153-159, 162-200, 202-203, 206-219, 221-227, 231-244, 246-257, 259-263, 272-317, 321-323, 411-536, and 542. In further response to the Examiner's request, Applicants submit that the cited pages are directed to the prosecution of the pending parent application, which includes several limitations similar to those found in the instant application and, therefore, respectfully request that the Examiner acknowledge consideration of at least the cited pages of the NPL document in a subsequent communication.

*Finality of Office Action is Premature*

The Examiner urges that Applicants' amendments necessitated the new grounds for rejection. However, the recent amendments merely clarified the claims by adding the word "embedded" prior to a subsequent reference to the word "rules" – which is consistent with the prior reference to the initial reference to "embedded rules" in each amended claim. Thus, no new matter was added by the amendments and there was no change in the scope of the claims. Furthermore, the new grounds of rejection is one in which a reference previously relied upon has been deleted and the rejection reformulated to be based upon Raveis and GMD. In fact, the Examiner previously stated on the record that "the combination of Raveis and GMD <u>does not disclose</u> the following limitations ... *"wherein said user interface is dynamically controlled as a function of the at least one attribute defined in the second table."* (Office

Action dated Oct. 20, 2008; p. 5, middle; underlining added, italics in original). Thus, the finality of the current Office Action is premature in that the Examiner had prior opportunity to present the current rejection, and has now urged new grounds – which appear to be based on a new, opposite interpretation of the GMD document rather than any amendment to the claims. Withdrawal of the finality of the instant application is respectfully requested such that Applicants may further consider amendments to the claims as of right.

*Rejections Traversed*

With respect to the new rejection of Claim 1-13 and 15-20, which were newly rejected under 35 USC §103(a) as being unpatentable over Raveis in view of GMD, and claim 14, which was rejected under 35 USC §103(a) as unpatentable over Raveis in view of GMD and Bisbee, Applicants respectfully traverse both rejections as again failing to set forth *prima facie* obviousness. The rejections are incomplete and continue to fail to disclose all of the elements recited in independent **claims 1, 7 and 17**.

As noted above, the Examiner previously acknowledged in the record of this application that a combination of Raveis and GMD does not teach a user interface dynamically controlled as a function of the at least one attribute defined in the second table, as recited in claim 1 for example. Now, however, the Examiner urges at p. 4 of the August 5, 2009 Final Office Action that GMD does indeed teach such a limitation. Applicants respectfully disagree and question the Examiner as to why a new interpretation of GMD is being presented in a Final Office Action. And, Applicants urge that the Examiner was correct in the first interpretation of GMD and the rejection should, therefore, be withdrawn.

Furthermore, the Examiner now sets forth the following teachings of GMD as allegedly disclosing the claimed limitation:

- *and at least a second table defining at least one attribute of a display of information associated with said property transaction*

- *wherein said user interface is dynamically controlled as a function of the at least one attribute defined in the second table.*

(see at least page 1, "Software Features":... " ...After entering your data and executing a user proof, you transmit your loan file to GMD's national service center for processing...you may choose to reroute your documents to another office, closing agent, title company or attorney. If you are using GMD's FAX-In Service Bureau, you simply fax or E-mail a worksheet to our national service center and we will input your data, perform a quality assurance review, print the documents and deliver them to you electronically...";

and Products and Services Process Flow Chart: Create Documents: GMD Software Document Engine.

(Final Office Action, Aug. 5, 2009; p. 4)

The Examiner's prior acknowledgement that GMD did not teach the independent claim limitations aside, the above-excerpted portions of GMD do not teach the recited limitations of any of the rejected independent claims. For example, where is the discussion of "a second table defining at least one attribute of a display ... wherein the user interface is dynamically controlled as a function of the at least one attribute"? The Examiner has interpreted GMD as disclosing entering data, a user proof, transmitting loan file, rerouting documents, faxing to national service center, quality assurance review, print documents and electronic delivery, but fails to show how such teachings are appropriately interpreted as teaching the limitations alleged. Absent such teachings, however, the alleged combination fails to establish *prima facie* obviousness. Apparently recognizing this failure, the Examiner further urges, at the bottom of pages 4 and 13 that such limitations are "old and well known in the art of software programming..." If that is the case, Applicants

respectfully challenge the Examiner to show such teachings. Absent specific teachings, it is merely the Examiner's conjecture that is improperly relied upon as the basis for the rejection.[1] Accordingly, Applicants request withdrawal of the unsupported rejection.

The Examiner continues to allege that several limitations of the independent claims are taught by GMD. While the Examiner has referred to sections of the GMD document, Applicants remain unable to determine where the limitation of "a database having embedded rules wherein the embedded rules define a work-flow for the property transaction" are taught in the cited sections. Indeed, it appears that the Examiner has taken "official notice" of such limitations as the bottom of p. 4 of the Final Office Action suggests that the limitation is "old and well known in the art of software programming" (p. 4, last para.) Applicants respectfully remind the Examiner that the limitation is relative to the database, and embedded rules within a table in the database.[2] No such feature or characteristic is believed to be described in GMD, or the combination of Raveis and GMD for that matter. Similarly, Applicants respectfully maintain that the further limitation of "a second table defining at an attribute of a display of information associated with said property transaction," as set forth, for example, in claim 1 is also not found in the GMD document.

Moreover, Applicants previously urged that the Examiner failed to establish that the GMD documents relied upon for the rejection were published or otherwise available prior to filing of the instant application. Applicants further requested that in the event the rejection was maintained, the Examiner specifically identify the teachings relied upon in GMD and provide information to establish that GMD was available as a reference. It does not appear that the date of the GMD documents has been established as the date appearing

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[1] Applicants also point out that in setting forth a response to arguments at p. 13 the Examiner refers to Bisbee and, thus, it is not clear whether Bisbee is intended to address the rejection of the independent claims where Bisbee has been withdrawn from the current rejection, or of the dependent claim 14.

[2] Applicants further note for the Examiner's consideration, pp. 31-35 (e.g., see p. 33; p. 3 of BAPI Decision, last para.) of the NPL document referred to above for a related application, which is a BAPI

thereon is indicated as 10/10/2008. In the event the Examiner is urging an earlier date for such documents it is incumbent upon the Examiner to provide evidence in support of such.

As for the basis for the alleged combination of Raveis and GMD, Applicants continue to urge that the Examiner has not established how such a combination would have been obvious. Rather, the Examiner merely alleges that the combination would have been obvious "because this would be a more efficient way for storing, creating and delivering high-quality closing documents via the web," at p. 5 of the Office Action. It is believed that this is merely hindsight reconstruction of the claimed invention based upon the claims as a recipe and that the Examiner has not explained such a combination based upon logic or sound reasoning in the absence of such a suggestion. In view of the failure to establish a teaching of all of the limitations of claim 1, or plausible basis for the arguable combination, *prima facie* obviousness has not been established to which Applicants can or should respond. In view of the failure to establish *prima facie* obviousness, Applicants respectfully request that the rejection be withdrawn with respect to independent claims 1, 7 and 17 and all claims dependent therefrom.

For purposes of brevity, Applicants urge that the dependent **claims 2-6, 8-13, 15-16 and 18-20** are similarly patentable for the reasons set forth herein relative to the independent claims from which they depend. Applicants reserve, once again, the right to separately address the dependent claims in more detail in a subsequent response or on appeal should the current rejection be maintained.

As for the rejection of **claim 14**, Applicants respectfully urge the same arguments as set forth above relative to independent claim 7, which are incorporated herein by reference. Applicants further note that claim 14 recites an object oriented structure, which the Examiner acknowledges as not being taught by Raveis or GMD. Rather Bisbee is relied upon as teaching such a

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decision affirming Applicants interpretation of a similar limitation, albeit in regard to a different document.

structure, yet the cited section of Bisbee, or for that matter any section of Bisbee, fails to disclose an "object oriented structure." Applicants respectfully traverse the rejection of claim 14.

While Applicants acknowledge that structures are discussed in Bisbee, and even that inner and outer data structures are discussed, Applicants fail to understand what the Examiner has relied upon as teaching the recited "object oriented structure" as set forth in claim 14. Thus, in addition to the distinctions noted relative to the independent claims, Applicants respectfully urge that the Examiner has not established where the limitations of claim 14 are set forth and the rejection should be withdrawn.

In view of the foregoing remarks and proposed amendments, entry of the amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

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